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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) E0295.70190US00	
		Application Number 10/731,790-Conf. #4910	Filed December 9, 2003
		First Named Inventor Michael Kilian et al.	
		Art Unit 2166	Examiner K. B. Pham
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>57,866</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 45%; text-align: center;">  _____ Signature Scott J. Gerwin Typed or printed name 617.646.8000 Telephone number March 8, 2011 Date </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

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Dated: <u>March 8, 2011</u>	Signature: <u>Danielle Calder</u>

Docket No.: E0295.70190US00
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael Kilian et al.
Serial No.: 10/731,790
Confirmation No.: 4910
Filed: December 9, 2003
For: Method And Apparatus For Data Retention In A Storage System
Examiner: Khanh B. Pham
Art Unit: 2166

Certificate of Electronic Filing Under 37 CFR 1.8

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Dated: March 8, 2011

Signature: Daruelle Calder

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the rejections in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

REMARKS

The claims in this application stand rejected under 35 U.S.C. §103. A Pre-Appeal Brief Conference is appropriate because these rejections are based upon clear legal deficiencies.

A. The Examiner Has Failed To Establish A *Prima Facie* Case Of Obviousness

The Examiner rejects claim 65, asserting that this claim is obvious over Stuart and McGovern. In the “Background of the Invention” section, McGovern describes a number of prior art Write-Once-Read-Many (WORM) systems and identifies deficiencies with each of them. The “Summary of the Invention” and “Detailed Description” sections of McGovern describe a different WORM system that McGovern contends does not have the deficiencies of the prior art WORM systems described in the Background of the Invention section.

In the Examiner’s rejection, the Examiner has asserted that some claim limitations are taught by the portion of McGovern that describes the prior art WORM systems (i.e., in the Background of the Invention section) and that some claim limitations are taught in the Summary of the Invention section of McGovern, which describes an entirely different WORM system. Specifically, on pages 4-5 of the Final Office Action, the Examiner contends that the limitation of claim 1 that recites, “wherein a previously-defined retention period for the unit of content is stored in the unit of content...and wherein the at least the portion of the content of the unit of content includes the previously-defined retention period,” is taught partially in ¶0017 of McGovern and partially in ¶0020.

Notably, ¶0017 of McGovern is in the Background of the Invention section of McGovern and describes a prior art WORM storage system marketed under the trade name Centera (McGovern ¶¶0016-0018). McGovern states that a deficiency with this type of storage system is that, because it utilizes digital hash values (called content addresses) to access and retrieve records, a proprietary API is needed to enable applications to interface with the storage system (McGovern, ¶¶0016-0018).

However, ¶0020 does not relate to the Centera storage system described in ¶¶0016-0018. In ¶0020, which is in the “Summary of the Invention” section, McGovern describes an entirely

different WORM storage system, and states that one of the benefits provided by this storage system is that it does not require the use of a proprietary API.

The Examiner has selected entirely unrelated portions of McGovern that describe entirely different systems and somehow combined them to assert that together they teach the above-discussed limitation of claim 65. The Board of Patent Appeals and Interferences has consistently held that this picking and choosing of claim limitations from different embodiments is improper.

For example, in *Ex parte Sato* (Appeal No. 2009-003331) (non-precedential), the claims were directed to an electro-deionization apparatus which introduced deionized water from desalting compartments into a specific location in concentrating compartments or allowed concentrated water to flow out of a specific location in the concentrating compartments. The Board overturned the rejection, holding that the "[t]he Examiner has combined the Liang '037 Figures 1 and 13 without establishing a direct relation of the relied-upon features (Decision, p. 5)."

The Examiner has not provided any reasoning explaining why one of skill in the art would have incorporated the relied-upon aspects of the Centera system (described at ¶0017 in the Background of the Invention section of McGovern) with the WORM system described in the Summary of the Invention section of McGovern. For this reason, the rejection of claim 1 is legally deficient.

Prior to allowing this appeal to proceed to the BPAI, the Conferees should require the Examiner to demonstrate that he has set forth *on the record* a reason explaining why one of skill in the art would have combined the Centera system described in the Background Of The Invention section of McGovern (i.e., at ¶¶0016-0018) with the entirely different WORM system described in the Summary Of The Invention section of McGovern.

B. The Asserted Combination Of Stuart and McGovern Fails To Disclose Or Suggest That, “The At Least The Portion Of The Content Of The Unit Of Content [From Which The Content Address Is Generated] Includes The Previously-Defined Retention Period.”

Claim 65 patentably distinguishes over the asserted combination of Stuart and McGovern because this combination fails to disclose or suggest that, “the at least the portion of the content of the unit of content [from which the content address is generated] includes the previously-defined retention period.”

Even if McGovern were somehow modified to combine the Centera system described in the Background of the Invention section with the system described in the Summary of the Invention section in ¶0020, the resulting system would still not compute the content address from the metadata of the file that specifies its retention date.

Specifically, in ¶0020, McGovern discloses that the retention date for a file is stored in the file’s “last access time” property/attribute field, but there is no disclosure or suggestion in McGovern that any property/attribute fields for a file would be input to the hashing function with the rest of the file content to generate the content address for the file.

Indeed, doing so would make little sense. Specifically, WORM stands for “Write Once, Read Many,” which means that once a record is written, it cannot be changed or modified, but can only be read. As explained at ¶0010 of McGovern, Securities and Exchange Commission rules require that certain documents be stored and remain unchanged and unchangeable for a number of years. Using a content address for a record in WORM systems allows for verification that a previously-stored record has not been changed since it was stored. In particular, the content address for the record may be computed when the record is initially stored. When the record is subsequently accessed, the content address may be recomputed and the recomputed content address may be compared to the originally-computed content address. If the originally computed content address matches the recomputed content address, it is known that the content of the record has not changed. If the recomputed content address does not match the originally-computed content address, then it is known that the record has become corrupted or been altered. Indeed, as stated at ¶0018 of McGovern, “[m]odification of existing objects is impossible because any changes in the

contents of an object will result in a new content address, and hence a new object being created in the storage system.”

As explained below, McGovern discloses that the properties/attributes of a file are able to be modified after the file has been stored. Thus, these properties/attributes cannot be input into the hash function that is used to generate the content address for a file because, if these properties were used in generating the content address, then modifying the properties/attributes would result in a different content address being created.

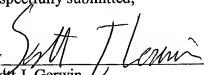
Specifically, in ¶0127 and Figure 12, McGovern discloses that the file attribute that stores the retention period can be modified after the initial setting of the retention period. If, as the Examiner contends, the file attribute that is used to store the retention period were to be used in generating the content address for the file, modifying this attribute in the manner described in ¶0127 would alter the content address for the file and would defeat the purpose of using a content address. As such, it is clear in McGovern that the content address for a file is not generated from the attribute that stores the retention period value. Stuart does not cure this infirmity of McGovern.

Prior to allowing this appeal to proceed to the BPAI, the Conferees should require the Examiner to explain why believes the file attribute that stores the retention period would be input to the hashing function that generates the content address for a file, when doing so would cause the content address to change when this file attribute is modified and would defeat the purpose of using content addressable storage.

Dated: March 8, 2011

Respectfully submitted,

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